UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/597,196	06/20/2000	John Zimmerman	US000127	6011

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EXAMINER
SHINGLES, KRISTIE D

ART UNIT	PAPER NUMBER
2444	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	09/597,196	ZIMMERMAN, JOHN
	Examiner	Art Unit
	KRISTIE D. SHINGLES	2444

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *7/22/2010*.
2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *5,7,9,10 and 12-25* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) *5,7,9,10,12-20,24 and 25* is/are rejected.
7) ☒ Claim(s) *21-23* is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☐ All   b) ☐ Some * c) ☐ None of:
      1. ☐ Certified copies of the priority documents have been received.
      2. ☐ Certified copies of the priority documents have been received in Application No. _____.
      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendments
Claims 1-4, 6, 8 and 11 are cancelled.

Claims 5, 7, 9, 10 and 12-25 are pending.

Response to Arguments

I.   Applicant's arguments filed 7/22/2010 have been fully considered but they are not

persuasive.

> Applicant argues that the cited prior art, *Gershman et al*, fails to teach
> "controlling the appliance in accordance with the user preference data" because in
> the applied citation *Gershman et al* sends the user profile information to the hotel
> computer but Applicant submits that "there is no disclosure or suggestion of
> controlling the appliance in accordance with the user preference data".

> Examiner respectfully disagrees. *Gershman et al* clearly teach illustratively in

Figures 10A-17 and in the disclosure (*col.30 line 55-col.31 line 28, col.32 line 9-col.35 line 34*),

that the user makes a request from web browser at the user's appliance and receives the user's

profile information from the profile server, which is sent to the user's appliance to effectively

control the appliance. Applicant's argument regarding the hotel computer example does not

preclude the actual implications and actions that take place on the hotel computer when the user's

profile is received. The term "controlling" is very broad and in the case of the hotel computer

example, although the language of "controlling" is not explicitly used, *Gershman et al's*

teachings still adequately fulfill the function of controlling in accordance with the user's

preference data. *Gershman et al's* teaching of the hotel computer/appliance is sufficient in fulfilling the functionality of the claim language, because the hotel computer will display and present the user's profile preference data for use, wherein the received user profile information will take precedence (over other non-received user profiles) in order to access the received user's preferences and identification data for any pending transactions. Applicant's arguments are therefore unpersuasive and the rejections under the cited prior art is maintained.

Allowable Subject Matter - Objection

II.   <u>Claims 21-23</u> are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 21 cites "The method of claim 9, wherein reconfiguring the appliance includes creating a composite of the portion of the first configuration data and the portion of the second configuration data". The cited prior art, *Gershman et al* with *Tan et al,* teach configuring the appliance based on the first remote device/smartcard and upon removal of the first remote device/smartcard, using another second remote device/smartcard to configure the appliance based upon the second remote device/smartcard. However, the prior art fails to teach or suggest creating a composite of the both configurations received from first and second remote devices/smartcards.

Claim 22 cites "The method of claim 12, further including reconfiguring the appliance to the first configuration after removal of the second remote device from a vicinity of the

appliance". Cited prior art *Hanko et al* (US 6,912,578) teaches reconfiguring the appliance to its original default configuration state after removal of a remote device/smartcard (*col.3 lines 40-53, col.5 lines 18-30, col.9 lines 38-57, col.11 lines 10-41, col.13 lines 38-54*), yet fails to teach suggest configuring the appliance to the first configuration of first remote device/smartcard after removing the second remote device/smartcard from the appliance. Claim 22 would be allowable written in independent form including all of the limitations of the base claim and any intervening claims.

Claim 23 dependent on Claim 22 cites "The method of claim 22, further including measuring a time duration after the removal of the second remote device, and wherein reconfiguring the appliance to the first configuration occurs when the time duration exceeds a predefined persistence period". Claim 23 depends from Claim 22 as explained above and likewise would be allowable written in independent form including all of the limitations of the base claim and any intervening claims.

In light of the above indications of allowable subject matter, the base independent Claim 9 would be allowable over the prior art if the limitations from Claim 21 were incorporated into its claim language, or the limitations of Claim 22, or the limitations of Claims 22 and 23.

Claim Rejections - 35 USC § 103

III.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

IV.   Claims 5, 7, 9-10, 12-20 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Gershman et al* (US 6,199,099) in view of *Tan et al* (US 2001/0045451).

      a.   **Per claim 14**, *Gershman et al* teach the method of controlling an appliance, the

method comprising:

- receiving, at the appliance, an address of an external relay server (*Figures 10A and 10B, col.30 line 55-col.31 line28—receiving at the appliance an address of the Integrator Web Server for access to the Invention Value Network*);

- transmitting, from the appliance, a first request to the relay server (*Figures 17-19, col.31 line 29-38—transmitting a request from the appliance to the web server*),

- receiving, at the appliance, a profile address from the relay server, based on the first request (*Figure 17, col.34 line 58-col.35 line 22—receiving a address of the and certificate access to the profile gateway server*),

- transmitting, from the appliance, a second request to a profile server corresponding to the profile address (*col.35 lines 20-45—transmitting from the appliance a request to the profile server*),

- receiving, at the appliance, data from the profile server, based on the second request (*col.35 lines 20-45 and 51-60—receiving at the appliance data from the profile server*); and

- controlling the appliance in accordance with the user preference data (*col.35 lines 20-45 and 51-60—controlling the appliance bases on the user preference data received from the user's profile*).

Gershman et al teach receiving the address of web server on the appliance's web browser (*col.30 line 55-col.31 line28*) and smart card access (*Figure 17, col.35 lines 1-7*); yet fail to explicitly teach receiving, at the appliance, an address of an external relay server from a remote device. However, *Tan et al* teach receiving the address of an external access/web server from a smart card (*page 1 paragraphs 0008 and 0010-0013; page 2 paragraph 0023; page 3*

paragraph 0026; page paragraph 0032-0035), upon which the access server generates an authentication cookie that allows the user's browser access to additional servers on behalf of the user.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Gershman et al* with *Tan et al* for the purpose of equipping a smartcard with web server access abilities, in order to provide specific data from the smartcard to a particular server for user authentication or for secure access to a specific website. Using smartcards to supply certain information useable by a smartcard reader of an appliance is a well-known technology used in the networking art for accessing information.

b.   **Claim 5** differs in statutory class, yet contains limitations that are substantially equivalent to claim 14 and is therefore rejected under the same basis.

c.   **Regarding claim 15,** *Gershman et al* with *Tan et al* teach the method of claim 14, wherein the remote device is a radio-frequency device that transmits the address associated with the relay server (*Gershman et al—Figure 17, col.35 lines 1-31; Tan et al—page 2 paragraph 0023; page 3 paragraph 0026; page 4 paragraphs 0032-0035*).

d.   **Regarding claim 16,** *Gershman et al* with *Tan et al* teach the method of claim 14, *Gershman et al* the method further including receiving, at the appliance, an address associated with an other relay server from another remote device; transmitting, from the appliance, a third request to the other relay server, based on the address associated with the other relay server; receiving, at the appliance, another profile server from the other relay server; transmitting, from the appliance, a fourth request to another profile server corresponding to the other profile address; receiving, at the appliance, user preference data from the other profile server based on

the fourth request, and controlling the appliance in dependence upon at least a portion of the other user preference data (*Figures 17-19, col.34 line 58-col.35 line 22, col.36 lines 51-57, col.38 lines 10-42—It would have been obvious based on the teachings of Gershman et al in view of Tan et al to use additional remote devices that supply and access a relay web server address and receive a user's preferential data from a profile database server*).

     e.   **Claim 9** contains limitations that are substantially similar to claim 16 and is therefore rejected under the same basis.

     f.   **Regarding claim 17,** *Gershman et al* with *Tan et al* teach the method of claim 14, wherein the address of the relay server includes a Uniform Resource Locator (URL) that is stored at the remote device (*Gershman et al—Figures 10A and 10B, col.30 line 55-col.31 line28; Tan et al—pages 1-2 paragraphs 0012-0013; page 2 paragraph 0023; page 3 paragraphs 0024-0026*).

     g.   **Claims 24 and 25** are substantially similar to claim 17 and are therefore rejected under the same basis.

     h.   **Regarding claim 18,** *Gershman et al* with *Tan et al* teach the appliance of claim 5, wherein the communications device is a wireless device that is remote from the appliance (*Gershman et al—col.2 lines 56-67; Tan et al—Abstract, page 1 paragraphs 0006-0011*).

     i.   **Claim 19** is substantially similar to claim 17 and is therefore rejected under the same basis.

     j.   **Regarding claim 20,** *Gershman et al* with *Tan et al* teach the appliance of claim 5 wherein the controller is configured to determine an address of the relay server based on the

device identifier (*Gershman et al—Figures 10A and 10B, col.30 line 55-col.31 line28; Tan et al—page 1 paragraphs 0006-0011*).

k.   **Regarding claim 7,** *Gershman et al* with *Tan et al* teach the method of claim 9, wherein each of the first remote device and the second remote device correspond to a portable device (*Gershman et al—Figure 17, col.35 lines 1-31; Tan et al—page 2 paragraph 0023; page 3 paragraph 0026; page 4 paragraphs 0032-0035*).

l.   **Regarding claim 10,** *Gershman et al* with *Tan et al* teach the method of claim 9, wherein each of the first and second remote device corresponds to a radio frequency identification device (*Gershman et al—Figure 17, col.35 lines 1-31; Tan et al—page 2 paragraph 0023; page 3 paragraph 0026; page 4 paragraphs 0032-0035*).

m.   **Regarding claim 12,** *Gershman et al* with *Tan et al* teach the method of claim 10, wherein delivering the first and second access data includes co-locating the radio frequency identification device with the appliance (*Gershman et al—Figure 17, col.35 lines 1-31; Tan et al—page 2 paragraph 0023; page 3 paragraph 0026; page 4 paragraphs 0032-0035*).

n.   **Regarding claim 13,** *Gershman et al* with *Tan et al* teach the method of claim 9, wherein the first configuration data includes configuration data relating to the appliance and configuration data relating to another type of appliance (*Gershman et al—Figure 17, col.35 lines 1-31; Tan et al—Figures 1 and 2, page 2 paragraphs 0022-0023*).

Conclusion

V. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure: Herz et al (7630986), Kumar et al (7672879), Hughes (6892196).

VI. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

VII. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTIE D. SHINGLES whose telephone number is (571)272-3888. The examiner can normally be reached on Monday-Friday 9:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Kristie D. Shingles/
Examiner, Art Unit 2444